

**REMARKS**

Applicants express appreciation to the examiner for the interview granted to applicant's representative. At the interview, proposed amendments to each of the independent claims were discussed in view of the new grounds of rejection entered in this office action. It was generally acknowledged that the proposed amendments appear to amend the claims in a way that would avoid the rejections of record, subject to the examiner's consideration of this formal amendment when filed, as well as updating the prior art search.

Accordingly, by this paper, each of the independent claims (i.e. claims 1, 10-17) as well as dependent claims (12-15 and 19-21) have been amended, and claims 2-9, 11, 16, and 18 have been cancelled. Therefore, by this paper, claims 1, 10, 12-15, 17, and 19-21 are presented for reconsideration. Applicant respectfully requests reconsideration and favorable action in view of the matters discussed at the interview, the additional remarks herein, and the amendments as noted.

In the current office action, the examiner indicated that the amendments and arguments filed in applicants' previous amendment were fully considered and were persuasive, resulting in withdrawal of the rejections of record as noted in the first office action. However, new grounds of rejection were entered in this second, non-final action. Specifically, each of the claims were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,233,389 (Barton)<sup>1</sup>, a newly cited reference found when updating the search in response to applicants' prior amendment.

As presented herein, applicants' invention is directed to a method and a corresponding system adapted for use with a set-top box that receives digital programming content that is comprised of multiple channels, and wherein the programming content of each channel is provided to the set-top box in an encoded digital format determined by the provider of the content. Applicants' claimed invention is directed to a method and corresponding system for recording one or more selected channels without decoding them prior to recording so as to store them in the same encoded digital format as determined by the content provider in order not to

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<sup>1</sup> The Barton reference qualifies as "prior" art, if at all, under 35 U.S.C. § 102(e). Accordingly, applicants specifically reserve the right to challenge the "prior" status of the Barton reference and therefore any argument or comment made in reference to Barton herein, is made simply assuming for purposes for argument that Barton would qualify as a proper reference. Applicants specifically reserve the right to challenge the qualifying status of Barton at any time should such become necessary or desirable.

degrade the recording quality of the selected channels. In addition to not degrading the recording quality of the selected channels, applicants' invention also advantageously permits display of one of the recorded channels while recording another one or even recording a selected channel while it is being displayed.

As claimed (see, e.g. independent claims 1 and 10 directed to a method and claim 17 directed to a corresponding system), the digital programming content is received at the set-top box, with the digital programming content being comprised of any or any combination of satellite transmissions, cable television transmissions, local televisions, radio transmission, internet data, MPEG video or audio, video streams, or audio streams. The digital programming content is encoded in the digital format that is determined by a content provider and the digital format for at least one channel other than MPEG.<sup>2</sup> The programming content received at the set-top box is then isolated in order to select the at least one channel. The isolation and selection of the at least one channel is accomplished with a tuner, a demodulator, and transport demultiplexer of the set-top box receiver. The digital content of the at least one channel is then stored on a storage medium at the set-top box without decoding it, in order to store it using the same digital format with which the at least one channel is received at the set-top box, in order to store it without degrading it.

Optionally, in accordance with the claimed system and method (e.g., independent claim 1) the digital content of the second channel can be retrieved from the storage medium that has been previously stored, prior to decoding, and the second channel can then be decoded into an analog format for display, while storing the digital content of the at least one channel on the storage medium. As a further option a digital to analog decoder can be coupled to the transport demultiplexer so that the at least one selected channel can be simultaneously displayed while it is also being stored on the storage medium of the set-top box (see independent claim 17 and dependent claims 19-20).

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<sup>2</sup> Applicants and the Examiner disagree over whether this claim language could read "other than MPEG2." The Examiner expressed the view that this is not disclosed. However, Applicants disclosed (at p. 13 lines 8 - 9) that "For instance one channel may carry MPEG video streams while another channel may carry Internet related data." Claiming "other than MPEG2," a specific type of MPEG format, is therefore clearly supported and amounts to simply claiming less than Applicants disclose, something clearly permissible. Applicants reserve the right to assert this position in any later-filed related application.

As noted and discussed at the interview, Barton discloses a method which allows a user to store selected television broadcast programs while a user is simultaneously watching another program. Barton teaches a system and method in which input streams are input in a variety of forms, for example, National Television Standards Committee (NTSC) or PAL Broadcast, and digital forms such as Digital Satellite System (DSS), Digital Broadcast Services (DBS) or Advanced Television Standards Committee (ATSC). However, unlike applicants' claimed method and system, Barton does not then directly store selected channels from the input stream in the same digital format as they were prepared by the digital content provider.<sup>3</sup> Rather, as expressly taught by Barton, "the input section 101 produces MPEG streams. An MPEG2 transport multiplex supports multiple programs in the same broadcast channel, with multiple video and audio feeds and private data. The input section 101 (see figure 1) tunes the channel to a particular program, extracts a specific MPEG program out of it and feeds it to the rest of the system. . . . Such signals are decoded by the input section and passed to other sections as if they were delivered via an MPEG2 private data channel." Column 3, lines 43-62.

It is clear that Barton expressly teaches that all formats which are received from the input stream are encoded (see figure 1) by the input module 101 into an MPEG2 format for processing throughout the rest of the system.<sup>4</sup> Thus, unlike applicants' claimed method and system, which claims that at least one channel in a format other than MPEG is stored in the same format as selected by the content provider, clearly is not taught or suggested by Barton.

For at least the foregoing reasons, as noted and as generally acknowledged at the interview, applicants' claimed method and system are neither anticipated nor made obvious by Barton or any other prior art of record, either singly or in combination. Accordingly, favorable reconsideration and allowance are respectfully requested.

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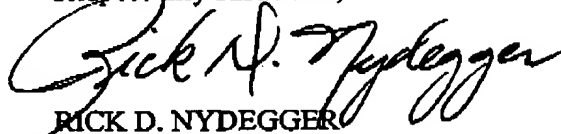
<sup>3</sup> As noted at the interview, this is again a point on which the Applicants and the Examiner have "agreed to disagree." The point is moot in view of the amendments herein, but nonetheless Applicants reserve the right to continue to challenge the Examiner's asserted interpretation of Barton on this point in any later-filed related application.

<sup>4</sup> The only possible exception to this might be a case where a digital format for a channel is MPEG2, in which case there would be no need to convert to MPEG2, but this is not expressly taught by Barton. See also fn 3 *supra*.

In the event of any remaining question which may be clarified by telephonic communication with the undersigned attorney of record, the examiner is invited to please initiate the same.

Dated this 1 day of July, 2005.

Respectfully submitted,

  
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